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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,495	09/20/2006	Peter Baur	028987.56522US	3130

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EXAMINER

LESLIE, MICHAEL S

ART UNIT	PAPER NUMBER
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3745

MAIL DATE	DELIVERY MODE
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08/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,495	Applicant(s) BAUR ET AL.	
	Examiner MICHAEL LESLIE	Art Unit 3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 13, 15, 18-25, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 12, 14, 16, 17, 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 10 and 11 are objected to because of the following informalities: Claim 10, Line 3, --system-- should be inserted after "piston"; and Claim 11, Line 1, "claim 11" should be --claim 10--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites "a respective first pressure chamber with a respective second pressure chamber", it is unclear whether or not any of these chambers corresponds with the "at least two pressure chambers" recited in claim 10.

Claims 20-22 are rejected due to their dependence from claim 19.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 11, 13, 15, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hafermalz (DE 19903511).

Hafermalz discloses a hydraulic linear drive having a piston/cylinder unit having a housing (1) in which an actuating piston system (3) is longitudinally displaceably arranged so as to define at least two pressure chambers (12, 13) which are actable upon by hydraulic oil via control conduits (not shown), having at least one piston rod (2) connected with the actuating piston system, and a sealing element (5A, 5B) operatively arranged at the actuating piston system for sealing off the at least two pressure chambers from one another, wherein the actuating piston system comprises a two-piece construction of a first and a second piston part having facing faces (not labeled) between which the sealing element is arranged. Wherein a sealing device carrier (5) is provided for the sealing element and which is axially guided on one of the piston parts, and the sealing device carrier is a separate component between the piston parts.

In further regard to claim 13, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Claims 10 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (3744382).

Williams discloses a hydraulic linear drive having a piston/cylinder unit having a housing (12) in which an actuating piston system (20, 46, 48) is longitudinally displaceably arranged so as to define at least two pressure chambers (not labeled) which are actable upon by hydraulic oil via control conduits (not shown), having at least one piston rod (16) connected with the actuating piston system, and a sealing element (20) operatively arranged at the actuating piston system for sealing off the at least two pressure chambers from one another, wherein the actuating piston system comprises a two-piece construction of a first and a second piston part (46, 48) having facing faces (~56) between which the sealing element is arranged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20, 23, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hafermalz (DE 19903511) in view of Blomquist (DE 3204358).

Hafermalz discloses a hydraulic linear drive as described above, but does not teach that the piston parts are step pistons, or that a longitudinal groove is provided at a surface area of a section of the step pistons that connects a respective first pressure chamber with a respective second pressure chamber.

Blomquist discloses a hydraulic linear drive having a piston (4) separating at least two pressure chambers (not labeled) wherein the piston includes stepped portions (10, 29) and a

Art Unit: 3745

longitudinal groove (30, 31) on a surface of a section of the piston for connecting a first pressure chamber with a second pressure chamber.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hafermalz by having the piston parts be step pistons, and to have a longitudinal groove provided at a surface area of a section of the step pistons that connects a respective first pressure chamber with a respective second pressure chamber as taught by Blomquist for the purpose of damping movement of the piston at the stroke ends.

Allowable Subject Matter

Claims 12, 14, 16, 17, 26, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 21 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LESLIE whose telephone number is (571)272-4819. The examiner can normally be reached on M-F 8:00am - 4:30pm.

Art Unit: 3745

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML
August 1, 2008

**/Michael Leslie/
Primary Examiner, Art Unit 3745**